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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/943,086

08/31/2001

Alan Asay

061047-0268225

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7590

08/31/2010

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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2437

MAIL DATE

DELIVERY MODE

08/31/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/943,086	<b>Applicant(s)</b> ASAY ET AL.	
	<b>Examiner</b> PAUL CALLAHAN	<b>Art Unit</b> 2437	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,57-69 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,57-69 and 71-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-26-2010</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-26-2010 has been entered.

2. Claims 1, 57-69 and 71-78 are pending and have been examined.

### ***Response to Arguments***

3. Applicant's arguments filed 12-3-2009 have been fully considered but they are not persuasive.

The Applicant argues that the rejections of the claims under 35 USC Sec. 102(e) as anticipated by Williams et al., US 5,815,657 are improper. The Applicant asserts that Williams fails to teach the claimed feature of sending transactional financial assurance with respect to an electronic infrastructure used in or with a transaction where the transactional financial assurance is *other than a digital signature of the electronic infrastructure or the electronic signals representing subscriber assurance*. The Applicant asserts that the reference cited by the Examiner: Williams at figure 5, column 13 lines

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40-53 (where the use of consumer and merchant certificates are taught), and col. 11 lines 31-38 (where X.509 certificates are described), do not read on the claim limitation because these are merely commonly used digital signatures, or are merely certificates such as public key certificates of the type described in the Applicant's Background section of his Specification. However, the Examiner respectfully maintains that the cited portions of the Williams reference do indeed read on this claim limitation. The Examiner maintains that types of certificates taught by Williams are not mere public key certificates or mere digital signatures. For example The X.509 type certificate was designed to allow the certificate to convey a great deal more information than a mere public key certificate. Such a certificate has many extensions and fields, and is commonly known in the art as capable of conveying financial transaction information among other types.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 63-69 and 71-78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed towards a software product. However, they do not positively recite any limitation that specifies the software as being embodied in a *non-transitory* computer-readable medium. Therefore the claims set forth only functional

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descriptive language and are non-statutory since this does not fall into one of the classes of invention eligible for the grant of a US patent. Unless embodied in a non-transitory computer-readable medium the software in and of itself cannot be considered as a computer component, and hence cannot effect a change of state of a processor to produce a useful or tangible result.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 57-61, 63-69, 71, 73, 74, and 76-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al., US 5,815,657.

As for claim 1, Williams et al. teaches a method of managing reliance in an electronic transaction system (Abstract) the method comprising: obtaining electronic signals representing subscriber assurance of an attribute of a subscriber to the system (fig. 29), the subscriber assurance issued by a certification authority hardware mechanism (fig. 30, col. 11 lines 30-37, col. 36 lines 63-67, col. 37 lines 1-12); obtaining electronic signals representing a request for transactional financial assurance with respect to electronic infrastructure used in or with a transaction involving the subscriber, the transactional financial assurance being other than a digital signature of the electronic infrastructure or the electronic signals representing subscriber assurance (col. 13 line 40 through col. 14 line 23: the Payment Manager receives the request for transactional assurance (i.e., authorization to pay or payment) from the merchant, and receives certificate information from the user (user's wallet manager)); determining whether to provide the requested transactional assurance, based on at least the subscriber assurance (col. 13 line 40 through col. 14 line 23: the Payment Manager receives the request for transactional assurance (i.e., authorization to pay or payment) from the merchant, and receives certificate information from the user (user's wallet manager)) ; and, depending on the said determining, issuing electronic signals representing the requested transactional assurance to the relying party (fig. 34: Payment Window).

As for claim 57, Williams teaches the method of claim 1, wherein the subscriber assurance comprises (a) an identification assurance of the identity of the subscriber, or (b) an authorization assurance of authorization of the subscriber, or (c) both (a) and (b) (col. 13 line 41 through col. 14 line 6: Payment Manager receives a user certificate containing I.D. information).

As for claim 58, Williams teaches the method of claim 1, wherein the subscriber assurance comprises electronic signals representing a certificate (col. 13 line 41 through col. 14 line 6: Payment Manager receives a user certificate containing I.D. information).

As for claim 59, Williams teaches the method of claim 1, wherein the determining is based also on information provided by the relying party (col. 13 line 41 through col. 14 line 6: Payment Manager receives a user certificate containing I.D. information and certificate information from the Merchant).

As for claim 60, Williams teaches the method of claim 1, wherein the request for transactional assurance comes from the relying party (col. 13 lines 40-53: Merchant payment request also contains financial assurance information such as the merchant certificate sent to the payment manager).

As for claim 61, Williams teaches the method of claim 1, wherein the request for transactional assurance includes a request for a guarantee of an aspect of the transaction and comprising (col. 13 lines 40-50: Merchant sends transaction details and his certificate): validating information in the request for transaction financial assurance to determine whether to provide the guarantee for the aspect of the transaction (col. 16 lines 19-25: Merchant is verified); and sending electronic signals representing an indication of whether the aspect of the transaction will be guaranteed (col. 16 lines 19-25: a message is sent as to whether Merchant is verified or not, and therefore whether payment will be made or not).

As for claim 76, Williams teaches the method of claim 1, wherein the electronic infrastructure comprises electronic signals representing a certificate and the transactional financial assurance with respect to electronic infrastructure comprises an assurance selected from the following: assurance regarding the authenticity of the certificate, assurance regarding the accuracy of the certificate, or assurance regarding the validity of the certificate (fig. 5, col. 13 lines 40-53).

Claims 63-69, 71, 73, 74, 77, and 78 are directed towards a computer program that directs a computer to carry out the method steps of claims 1 and 57-61. Claims 63-75 contain substantially the same limitations as claims 1 and 57-62. Therefore claims 63-75 are rejected on the same basis as claims 1 and 57-61.



***Allowable Subject Matter***

9. Claims 62, 72, and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if the rejections under 35 USC Sec. 101 were overcome.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Emmanuel L. Moise/

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Supervisory Patent Examiner, Art Unit 2437